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10/535,219	12/27/2005	Jaume Prat Terradas	30607/41159	2004
4743 7590 11/19/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER				
DIAZ, THOMAS C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,219

Applicant(s)

PRAT TERRADAS ET AL.

Examiner

THOMAS DIAZ

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
- Paper No(s)/Mail Date 10/03/2005, 08/17/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the:

- "an actuator" of claims 24, 42, 43;
- "at least one gearing selected from a group of gearings comprising a toothed wheel gearing, a spindle gearing, a cam gearing, a chain drive, a belt drive, a V-belt drive, and a flexible shaft" of claim 44,
- "a second pedal assembly" of claim 45,
- "a link" of claim 26,

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 31 is objected to because of the following informalities: the claim recites "the first second and third paths". There appears to be comas missing after the words "first" and "second". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 44-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

Claim 44 recites "wherein the actuator is driven by at least one gearing selected from a group of gearings comprising a toothed wheel gearing, a spindle gearing, a cam

gearing, a chain drive, a belt drive, a V-belt drive, and a flexible shaft". Neither the specification nor the drawings support how the actuator is connected to and driven by these different gearings. A person of ordinary skill in the art would not understand how one could have multiple combinations of the different types of gearing would be connected to the actuator based on the disclosure.

Claim 45 and 46 recites "a second pedal assembly...". Neither the specification nor the drawings provide sufficient support for how the second pedal assembly would be jointly driven by a common adjustment means. How are the pedal assemblies connected such that they are driven by a common adjustment means?

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 44 recites "at least one gearing selected from a group of gearings comprising a toothed wheel gearing, a spindle gearing, a cam gearing, a chain drive, a belt drive, a V-belt drive, and a flexible shaft". This claim is an improper Markush group because it mentions "a group of gearings **comprising**". The scope of the claim is unclear since the group is not limited only to the gearings being mentioned. Perhaps changing "comprising" to "consisting" would resolve this issue.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 24, 26-33, 35, 40-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Prat et al. (DE 10033703).

Regarding claim 24, Prat et al. discloses a similar device comprising:

- a subpedal (fig.2, 20a) pivotably mounted to the motor vehicle;
- a pedal (fig.2, 10 and 30) slideably coupled to the subpedal by a first slide link (fig.2, 21 and 30a); and
- at least one positioning element (fig.2, 31 or 32) pivotably mounted to the subpedal and slideably mounted at the pedal by a second slide link (fig.2, 11 and 31a), so that the pedal glides relative to the subpedal during a pivoting of the positioning element effected by means of an actuator (fig.2, 40) acting on the positioning element or the pedal, wherein the positioning element is further mounted to the pedal by a third slide link (fig.2, 11 and 32a) separate from the second slide link.

Regarding claim 26, Prat et al. discloses the subpedal comprises a first elongated guide (fig.2, 21) and wherein the pedal is slideably supported within this first elongated guide by a link (fig.2, 30a), [so that the pedal is adjustable substantially in parallel to a longitudinal axis of the motor vehicle].

Regarding claim 27, Prat et al. discloses the pedal comprises second and third elongated guides (fig.2, 11; one on each side).

Regarding claim 28, Prat et al. discloses first, second, and third paths defined respectively by the first, second, and third elongated guides are arranged such that [when a force is applied to a foot-piece of the pedal, a locking in relative movement of the subpedal, the pedal and the positioning element to each other is produced].

Regarding claim 29, Prat et al. discloses the first, second, and third paths are arranged such that a foot-piece of the pedal follows a predetermined trajectory during adjustment of the pedal.

Regarding claim 30, Prat et al. discloses the pedal comprises a first pin (fig.1, 30a) engaging the first elongated guide, wherein the positioning element comprises a second pin (fig.2, 31a) engaging the second elongated guide, and wherein the positioning element comprises a third pin (fig.2, 32a) engaging the third elongated guide, wherein the first, second and third pins and the first, second, and third elongated guides constitute the first, second and third slide links.

Regarding claim 31, Prat et al. discloses the first second and third paths are substantially parallel to a plane defined by a longitudinal axis and a vertical axis of the motor vehicle (see fig.2).

Regarding claim 32, Prat et al. discloses a path defined by the first elongated guide is substantially straight (see fig.2).

Regarding claim 33, Prat et al. discloses second and third paths defined respectively by the second and third elongated guide are curved (see fig.2; they have a curved portion).

Regarding claim 35, Prat et al. discloses the positioning element is pivotable around an axis which is substantially parallel to a transverse axis of the motor vehicle (see fig.2).

Regarding claim 40, Prat et al. discloses the sub-pedal comprises two external parallel walls (fig.6, both side walls of 130) which are mechanically connected, wherein the at least one positioning element and the pedal are mounted in-between the two walls by means of a first, second, and third elongated guides and the first, second, and third pins (see fig.6; in this embodiment the pedal and positioning elements are located within the subpedal).

Regarding claim 41, Prat et al. discloses the at least one positioning element comprises a V-shaped plate pivotably mounted at a vertex of the V- shaped plate and wherein the second and third pins are arranged at the arms of the V-shaped plate (fig.2, both positioning elements 31 and 32 form a v-shaped plate and have a vertex at 50a, and second and third pins at the arms of the plate).

Regarding claim 42 and 43, Prat et al. discloses an actuator acting on the positioning element or the pedal [is driven by an electric motor or manually driven].

Regarding claim 44, Prat et al. discloses wherein the actuator is driven by at least one gearing selected from a group of gearings comprising a toothed wheel

gearing, a spindle gearing, a cam gearing, a chain drive, a belt drive, a V-belt drive, and a flexible shaft (see fig.2, actuator is a shaft).

Regarding claim 45, Prat et al. discloses at least a second pedal assembly so that the pedal assembly and the second pedal assembly form a pedal unit, wherein the positioning elements or the pedals of each pedal assembly are jointly driven for a joint adjustment (see fig.1).

Regarding claim 46, Prat et al. discloses only a single common adjustment means is used for adjustment (see fig.1).

9. Claims 24, 25, 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashihara (USPGpub 20020078784).

Regarding claim 24, Hayashihara discloses a similar device comprising:

- a subpedal (fig.4, 56) pivotably mounted to the motor vehicle;
- a pedal (fig.4, 28) slideably coupled to the subpedal by a first slide link (fig.4, 62); and
- at least one positioning element (fig.4, 26) pivotably mounted to the subpedal and slideably mounted at the pedal by a second slide link (fig.4, 34 and 38), so that the pedal glides relative to the subpedal during a pivoting of the positioning element effected by means of an actuator (fig.4, 24) acting on the positioning element or the pedal, wherein the positioning element is further mounted to the pedal by a third slide link (fig.4, 32 and 36) separate from the second slide link.

Regarding claim 25, Hayashihara discloses the positioning element consists only of a single element mounted to the pedal by the second and third slide links (see fig.4).

Regarding claim 36, Hayashihara discloses a rotation point (fig.4, point where elongated guide 62 connects to 26) of the positioning element is located below a rotation point (fig.4, point where actuator 24 connects to 56) of the subpedal.

Regarding claim 37, Hayashihara discloses the subpedal comprises a first elongated guide (fig.4, 62), and wherein a path defined by the first elongated guide is directed between the rotation point of the subpedal and the rotation point of the positioning element (see fig.4, a path defined by the upper portion of guide 62 is directed between the rotation points)11.

Regarding claim 38, Hayashihara discloses a rotation point (fig.4, 20) of the positioning element is located above a rotation point (fig.4 54) of the subpedal.

Regarding claim 39, Hayashihara discloses the subpedal comprises a first elongated guide (fig.4, 62), and wherein a path defined by the first elongated guide lies above the rotation point of the subpedal (see fig.4).

10. Claims 24, 26, 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Asano et al. (USP 5086663).

Regarding claim 24, Asano et al. discloses a similar device comprising:

- a subpedal (fig.3, 6) pivotably mounted to the motor vehicle;
- a pedal (fig.3, 18) slideably coupled to the subpedal by a first slide link (fig.3, 17 and 6a); and

- at least one positioning element (fig.3, 21) pivotably mounted to the subpedal and slideably mounted at the pedal by a second slide link (fig.3, 16), so that the pedal glides relative to the subpedal during a pivoting of the positioning element effected by means of an actuator (fig.3, 11) acting on the positioning element or the pedal, wherein the positioning element is further mounted to the pedal by a third slide link (fig.3, 16a) separate from the second slide link.

Regarding claim 26, Asano et al. discloses the subpedal comprises a first elongated guide (fig.3, 6a) and wherein the pedal is slideably supported within this first elongated guide by a link (fig.3, 17), so that the pedal is adjustable substantially in parallel to a longitudinal axis of the motor vehicle.

Regarding claim 34, Asano et al. discloses a path defined by the first elongated guide is arranged substantially horizontal when the pedal is not actuated (see fig.3).

Regarding the functional recitation(s) in the claim(s) above denoted by the "[]" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all the claimed structural limitations and therefore anticipates the claim. See MPEP 2114. Additionally, the apparatus is capable of performing the claimed functions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS DIAZ whose telephone number is (571)270-5461. The examiner can normally be reached on Monday-Friday 8:30am to 5:30pm, First Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Thomas Diaz/
Examiner, Art Unit 3656

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3656